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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,120	10/21/2003	Everett Roy Forman		2913
30771	7590	06/29/2007		
DAW SYSTEMS, INC. 47 SWEET ROAD BALLSTON LAKE, NY 12019				
EXAMINER				
RANGREJ, SHEETAL				
ART UNIT		PAPER NUMBER		
3626				
MAIL DATE		DELIVERY MODE		
06/29/2007		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/689,120

**Applicant(s)**

FORMAN, EVERETT ROY

**Examiner**

Sheetal R. Rangrej

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

*Prosecution History Summary*

1. Claims 1-7 are pending.
2. Claims 8-10 have been withdrawn.

*Priority*

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date of October 17, 2002 of provisional patent application no. 60/413,870.
4. The benefit claim filed on 10/21/2003 was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). If the application is an application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a non-provisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). If applicant desires the benefit under 35 U.S.C. 119(e) based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by: (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR

1.78(a)(2) or (a)(5) to the prior application (unless previously submitted); (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

*Claim Objections*

5. Claim 4 is objected to because of the following informalities: penicillin is used as an example of an “element” in a prescription. Appropriate correction is required.

*Claim Rejections - 35 USC § 101*

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because claims directed to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a

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physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Claims 1-7 fail to recite computer readable instructions that are executable and are embodied on a computer-readable medium. As such, the claim is merely directed to executing a computer program per se, which is non-functional descriptive material, and non-statutory.

Claims 1-7 are also rejected under 35 U.S.C. 101 because the claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” State Street, 149 F.3d at \*1373-74<, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 \*\*> (1966); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 recites the limitation “a computer software program that executes a method to produce accurate and legible prescriptions.” The claim is indefinite in the sense that it does not provide a particular method to produce accurate and legible prescriptions.

10. Claims 2-7 are dependent on claim 1, and therefore inherit the rejection.

*Claim Rejections - 35 USC § 102*

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kapp (U.S.

Publication No. 2001/0001144).

13. As per claim 1, Kapp teaches a computer software program for use by medical professionals at the point of care that executes a method to produce accurate and legible prescriptions (**Kapp: figure 4, 114**).

14. As per claim 2, the method of claim 1 is as described. Kapp further teaches wherein the method further comprises the step of: locating within a patient demographic database stored within the software program's files, a patient record (**Kapp: figure 4, 122; figure 5, 130**).

15. As per claim 3, the method of claim 2 is as described. Kapp further teaches wherein the method further comprises the step of: selecting a medication from a medical database stored within the software program's files, and then selecting a format for the prescription to be filled by a pharmacist (**Kapp: figure 15**).

16. As per claim 4, the method of claim 3 is as described. Kapp further teaches wherein the method further comprises the step of: once a medication is selected, the software program checks any known allergies of a patient. This is done by retrieving information from within the patient demographic file within the software program and cross-referencing that information with that of the chosen medication. If a prior sensitivity of a patient has been indicated within the software program in the past, then the software program searches each "element" of the indicated sensitivity (i.e. penicillin). In the event that penicillin is found to be an element within a prescribed medication, then a warning will appear on screen alerting the medical professional user as to the prior indicated allergy (**Kapp: para. 0063**).

17. As per claim 5, the method of claim 4 is as described. Kapp further teaches wherein the method further comprises the step of: once a medication is selected, the software program checks any all previously prescribed medications within the system and cross-references these medications with the currently prescribed medication to determine if there is a level of interaction that has been indicated by other users in the field of medicine and pharmaceuticals to ensure safe use. If a previously prescribed medication has an interaction that has been indicated

in the past with a currently prescribed medication, then the medical professional user will be alerted to this interaction and told the level of interaction; from high to low. This is done by cross-referencing "elements" and/or compounds of a medication against another medications "elements" and/or compounds (**Kapp: para. 0070**).

18. As per claim 7, the method of claim 6 is as described. Kapp further teaches wherein the method further comprises the step of: updating the information within the software program's patient information so that information can be easily retrieved, reviewed and worked with (**Kapp: figure 20**).

*Claim Rejections - 35 USC § 103*

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kapp (U.S. Publication No. 2001/0001144) in view of Edelson et al. (U.S. Patent No. 5,737,539).

21. As per claim 6, the method of claim 5 is as described. Kapp does not teach wherein the method further comprises the step of: printing a prescription; transmitting via fax a prescription; transmitting via e-mail a prescription.

Edelson teaches wherein the method further comprises the step of: printing a prescription; transmitting via fax a prescription; transmitting via e-mail a prescription (**Edelson: col. 32, 8-11**).



One of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of Kapp and Edelson with the motivation of providing flexibility to facilitating a physician's prescribing activities (**Edelson: col. 32, 12-18**).

*Conclusion*

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Albaum et al. (U.S. Patent No. 5,758,095) discloses a system and method for ordering and prescribing drugs for a patient.

-Lavin et al. (U.S. Patent No. 5,772,585) discloses a system and method for displaying allergy warnings.

-Mayaud (U.S. Patent No. 5,845,255) discloses an electronic prescription creation system for physician.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheetal R. Rangrej whose telephone number is 571-270-1368. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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6/15/07

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